

Case No. 18-1763

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

AMERICAN AXLE & MANUFACTURING, INC.,
Plaintiff-Appellant,

v.

NEAPCO HOLDINGS LLC AND NEAPCO DRIVELINES LLC,
Defendants-Appellees.

Appeal from the United States District Court
For the District of Delaware,
Case No. 15-CV-1168, Judge Leonard P. Stark

**NEAPCO'S RESPONSE TO COMBINED PETITION FOR
REHEARING AND REHEARING EN BANC**

December 17, 2019

Dennis J. Abdelnour
HONIGMAN LLP
155 North Wacker Drive
Suite 3100
Chicago, IL 60606
(312) 701-9300

J. Michael Huget
Sarah E. Waidelich
HONIGMAN LLP
315 E. Eisenhower Parkway
Suite 100
Ann Arbor, MI 48108
(734) 418-4254

*Counsel for Defendants-Appellees Neapco
Holdings LLC and Neapco Drivelines LLC*

U.S. Patent No. 7,774,911, Claim 22 (Appx35):

22. A method for manufacturing a shaft assembly of a driveline system, the driveline system further including a first driveline component and a second driveline component, the shaft assembly being adapted to transmit torque between the first driveline component and the second driveline component, the method comprising:

providing a hollow shaft member;

tuning a mass and a stiffness of at least one liner; and

inserting the at least one liner into the shaft member;

wherein the at least one liner is a tuned resistive absorber for attenuating shell mode vibrations and wherein the at least one liner is a tuned reactive absorber for attenuating bending mode vibrations.

CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rules 26.1 and 47.4, counsel for Defendants-Appellees Neapco Holdings LLC and Neapco Drivelines LLC, certifies the following:

1. The full name of every party represented by me is:

Neapco Holdings LLC
Neapco Drivelines LLC

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

Neapco Holdings LLC
Neapco Drivelines LLC

3. All parent corporations and any publically-held companies that own 10% or more of the stock of any party represented by me are:

Neapco Holdings LLC
Wanxiang Automotive Components, LLC

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this Court (and who have not or will not enter an appearance in this case) are:

Melanie K. Sharp
Robert M. Vrana
YOUNG CONAWAY STARGATT & TAYLOR, LLP
1000 North King Street
Wilmington, DE 19801
Telephone: (302) 571-6681

Brian J. Arnold,
formerly of HONIGMAN MILLER SCHWARTZ & COHN LLP (now
HONIGMAN LLP)

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal:

Not Applicable.

Dated: December 17, 2019

/s/ J. Michael Huget
J. Michael Huget
Sarah E. Waidelich
HONIGMAN LLP
315 East Eisenhower Parkway, Suite 100
Ann Arbor, MI 48108
Telephone: (734) 418-4254
Facsimile: (734) 418-4255

Dennis J. Abdelnour
HONIGMAN LLP
155 North Wacker Drive, Suite 3100
Chicago, IL 60606
Telephone: (312) 701-9300

*Counsel for Defendants-Appellees Neapco
Holdings LLC and Neapco Drivelines LLC*

TABLE OF CONTENTS

	Page
INTRODUCTION	1
ARGUMENT	5
I. The Majority Correctly Applied The Alice/Mayo Two-Part Test	5
A. At Step One, The Majority Clearly Found The Claims “Directed To” Hooke’s Law	5
B. Preempting Additional Natural Laws Further Underscores Patent-Ineligibility	6
II. The Majority Followed Binding Supreme Court Precedent In Rejecting American Axle’s Attempts To Identify An “Inventive Concept”	9
III. The Majority Did Not Resolve Fact Disputes	15
CONCLUSION	17

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>AK Steel Corp. v. Sollac & Ugine</i> , 344 F.3d 1234 (Fed. Cir. 2003)	14
<i>Alice Corp. Pty. Ltd. v. CLS Bank Int’l</i> , 573 U.S. 208 (2014).....	<i>passim</i>
<i>Bilski v. Kappos</i> , 561 U.S. 593 (2010).....	11, 14
<i>Electric Power Grp., LLC v. Alstom SA</i> , 830 F.3d 1350 (Fed. Cir. 2016)	2, 12
<i>Enfish, LLC v. Microsoft Corp.</i> , 822 F.3d 1327 (Fed. Cir. 2016)	4
<i>Interval Licensing LLC v. AOL, Inc.</i> , 896 F.3d 1335 (Fed. Cir. 2018)	2, 12
<i>Le Roy v. Tatham</i> , 55 U.S. 156 (1852).....	1, 2, 8, 11
<i>Mayo Collaborative v. Prometheus Laboratories</i> , 566 U.S. 66, 72 (2012).....	<i>passim</i>
<i>O’Reilly v. Morse</i> , 56 U.S. 62 (1853).....	<i>passim</i>
<i>Ultramercial, Inc. v. Hulu, LLC</i> , 772 F.3d 709 (Fed. Cir. 2014) (Mayer, J., concurring)	15
<i>Wyeth v. Stone</i> , 30 F. Cas. 723 (C.C.D. Mass. 1840).....	8, 11

NOTES

Unless otherwise indicated, all *emphasis* in this brief has been added.

INTRODUCTION

American Axle’s patent claims are sweeping in their breadth. American Axle and several of the amici say the claims recite the type of “industrial processes” that have “historically been eligible” for patent protection. Combined Petition for Panel Rehearing and Rehearing En Banc, Dkt. 79 (“Pet.”) at 8. But in truth the claims, as the majority correctly found, merely instruct one to “apply” Hooke’s law (a law of physics discovered centuries ago) in some “unbounded” way (ad hoc trial-and-error) to achieve a “desired result” (reduced vibrations). What’s worse, American Axle believes its claims cover *any* liner producing those desired results, “[e]ven if you didn’t try to [tune] and didn’t know you did it.” Opinion, Dkt. 70 (“Op.”) at 20 (quoting Appx699).

But telling an engineer to “apply” Hooke’s law using “ad hoc trial-and-error” “until a desired result is achieved” boils down to fundamental engineering design and “basic physics,” as American Axle’s own witnesses admit. Op. at 10 (quoting Appx1757), Op. at 15. As the record in this case bears out, the real-world consequence of these claims is that they “impede innovation more than” they “promote it.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

Claims that tell an engineer to “apply” “basic physics” to achieve a “desired result” fail at the threshold inquiry of Section 101. “A patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from

making the same thing by any means whatsoever.” *Le Roy v. Tatham*, 55 U.S. 156, 174-75 (1852). *O’Reilly v. Morse*, 56 U.S. 62 (1853), involving the discovery of the telegraph machine, illustrates the principle. It drew a clean distinction between claims that properly recite an *application* of a natural law, and claims that sought to monopolize the natural law itself. *Id.* at 112-120. This principle still guides Section 101 jurisprudence. Citing *Morse* for this very proposition, the Supreme Court in *Mayo Collaborative v. Prometheus Laboratories* “warn[ed]” “against upholding patents that claim processes that too broadly preempt the use of a natural law.” 566 U.S. 66, 72 (2012).

This Court has likewise held that Section 101 prohibits the patenting of “all solutions for achieving a desired result,” *i.e.*, the “‘principle in the abstract’ no matter how implemented.” *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1343 (Fed. Cir. 2018). “[T]he essentially result-focused, functional character of claim language”—claims that “effectively cover any solution to an identified problem”—“has been a frequent feature of claims held ineligible under § 101.” *Electric Power Grp., LLC v. Alstom SA*, 830 F.3d 1350, 1356 (Fed. Cir. 2016).

American Axle’s petition never cites, discusses, or distinguishes *Le Roy*, *Morse*, *Interval Licensing*, or *Electric Power*. That is the only way it can maintain that the “desired result” of “attenuating bending mode vibration” can somehow serve as the “inventive concept” to render its claims patent-eligible. But because the law

prohibits patenting “an effect, or the result of a certain process” “by any means whatsoever,” *Le Roy*, 55 U.S. at 174-75, the majority was right to reject this argument. A “direction to engage in a conventional, unbounded trial-and-error process does not make a patent eligible invention, *even if the desired result to which that process is directed would be new and unconventional.*” Op. 21-22.

American Axle’s other assertions misread the majority’s opinion, and regardless do not merit *en banc* consideration. *First*, American Axle argues that the majority could not identify a specific law of nature. But the majority was clear that the claims are directed to “tuning,” which is nothing more than saying “apply” Hooke’s law (the natural relationship between an object’s mass, stiffness, and the frequency at which it vibrates). The mere recognition by the majority that another law of nature—namely friction damping—may be implicated does not undermine the ineligibility finding. If anything, the fact that these sweeping claims may preempt an engineer’s use of *more than one* natural law only bolsters invalidity.

Second, the majority did not conflate the threshold inquiry of patent-eligibility with enablement. Rather, it rejected arguments by American Axle that the claims should survive based on *unclaimed* requirements. And it also rejected the argument that the desired result of the claimed process could provide the requisite inventive concept without reciting the alleged solution. This is not some “pseudo” application of the enablement standard, it is simply recognition of a principle firmly entrenched

in Section 101 jurisprudence. Thus, as it always has been, the *breadth* of a claim is critically material to the § 101 inquiry. The fact that breadth is *also* material to enablement (and written description, novelty, and obviousness as well) does not mean that it cannot be relevant to § 101.

Finally, the various different concerns voiced by the amici do not warrant *en banc* review either. Several of the amici commit the exact same error that they (incorrectly) attribute to the majority opinion: casting aside the actual claim for a high-level abstraction. But labeling these claims as “mechanical,” “industrial,” “manufacturing,” and “physical,” and declaring that all claims within those categories should be “patent-eligible” contravenes *Alice* and *Mayo*. Every claim must be analyzed individually within the Supreme Court’s framework, and this Court should decline the invitation to establish new categorical exceptions to § 101 scrutiny, as it has rightly done in the past. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (“We do not read *Alice* to broadly hold that all improvements in computer-related technology are inherently abstract....”).

For the same reason, any concern over the potential impact of this case on future cases is vastly overstated, and this case is narrowly limited to the unique claims at issue.

En banc review is unwarranted.

ARGUMENT

Despite broad pronouncements and dire predictions, America Axle’s petition makes only three select arguments: (i) the majority did not identify a precise natural law to which the claims are directed; (ii) the majority conflated the doctrines of patent-eligibility and enablement; and (iii) the majority engaged in fact-finding. None has merit, let alone constitutes the type of “exceptional” issue that merits *en banc* review.

I. The Majority Correctly Applied The Alice/Mayo Two-Part Test

A. At Step One, The Majority Clearly Found The Claims “Directed To” Hooke’s Law

American Axle never argues that the majority erred in finding the claims “directed to” Hooke’s law. Instead, American Axle contends that the majority failed “to articulate a precise natural law or abstract idea to which the claims are directed[.]” Pet. at 9. That is incorrect.

The majority, like the district court, found the claims “directed to tuning liners,” which in turn, it said, is nothing more than “stating a law of nature while adding the words ‘apply it.’” Op. at 10-11. That law of nature is “Hooke’s law,” the “natural law that mathematically relates the mass and/or stiffness of an object to the frequency with which that object oscillates (vibrates).” *Id.* at 10-11.

The majority premised its conclusion on the binding admissions of American Axle’s own witnesses, who testified that “tuning” is “basic physics”: “changing the

mass or the stiffness” of a liner to “adjust the frequency.” *Id.* at 10-11 (quoting Appx1757, Appx2547); *see also* Appx15 (“Since Hooke’s law governs the relationship between mass, stiffness, and frequency, the ‘tuning’ claim limitation does nothing more than suggest that a noise, vibration, and harshness (“NVH”) engineer [] consider that law of nature when designing propshaft liners to attenuate driveline vibrations.”). It also considered the undisputed admissions in the ‘911 patent itself, which made “clear” that “most aspects of the ‘911 patent were well known in the art,” and that the only alleged contribution was the vague notion of “tuning.” *Op.* at 10.

Thus, American Axle’s suggestion that the majority opinion is “based on a feeling that *some* undefined natural law or abstract idea may apply” is a bald mischaracterization. *Pet.* at 11 (original emphasis).

B. Preempting Additional Natural Laws Further Underscores Patent-Ineligibility

American Axle’s real contention is that the majority erred by not identifying *all* possible natural laws that the broad asserted claims may implicate and preempt. Like the dissenting opinion, American Axle seizes on the majority’s recognition that “other natural laws” may be involved in the “ad hoc trial-and-error process of changing the characteristics of a liner until a desired result is achieved.” *Op.* at 15, 19; *Pet.* at 9-10.

But the fact that American Axle’s broad claims may actually preempt “other natural laws” only further proves ineligibility. It is plainly enough under *Alice* and *Mayo* that these claims are “directed to,” and thus preempt the use of, at least one natural law—Hooke’s law. *See Alice*, 573 U.S. at 216 (the “concern” is “that patent law not inhibit further discovery by improperly tying up the future use of these building blocks of human ingenuity”) (quoting *Mayo*, 566 U.S. at 85).

Regardless, American Axle’s assertion that no one knows the *precise* natural laws at issue here is disingenuous. Below, Neapco argued that the claims are directed to two laws of nature: Hooke’s law and friction damping. *See Appx10-11*. The district court agreed, and the majority recognized as much, stating: “The district court concluded that ‘the Asserted Claims as a whole are directed to laws of nature: Hooke’s law and friction damping.’” *Op.* at 7 (quoting *Appx10*); *see also Appx16* (“the Asserted Claims ‘inform a relevant audience [NVH engineers] about certain laws of nature [Hooke’s law and friction damping]’”); *Appx11*. To be sure, on appeal Neapco focused its argument on Hooke’s law, and the majority did not reach the question of whether the claims *also* preempt friction damping. But the majority did not have to. Preemption of one natural law is enough.

American Axle’s argument would turn the principle underlying Section 101—preemption—on its head. *Alice*, 573 U.S. at 223. The broader the claims, and the more preemptive they are, the less likely one can identify *every* underlying natural

relationship involved. Take for example Archimedes’ principle of flotation, which the *Mayo* Court said could not be preempted by a “process consisting of simply telling boat builders to refer to that principle in order to determine whether an object will float.” *Mayo*, 566 U.S. at 78. No doubt such a claim may well implicate *other* natural principles, particularly if a boat builder is going to be successful, but it would not follow that the claims are any less preemptive and patent ineligible.

The same can be said about claiming the “right to cut ice by all means and methods,” found patent-ineligible in *Wyeth v. Stone*, 30 F. Cas. 723, 727 (C.C.D. Mass. 1840). That too may preempt multiple laws of physics and engineering principles, but the claim is invalid nonetheless. Indeed, the Supreme Court recognized this same point in *Le Roy* when it held that a “patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from making the same thing by any means whatsoever.” 55 U.S. at 174-75.¹

Notably, the *Alice* two-part framework relies heavily on step two—the search for an inventive concept that transforms a claim into a patentable *application*. Even if this Court were to over-designate claims as directed to ineligible subject matter at

¹ To the extent American Axle is arguing that the claims are *narrower* because they may implicate more than one natural law, that is also incorrect. Of course, if a claim recites an *application* of one natural law and combines it with an *application* of another, that would narrow the claims. But here, there is no such application recited in the claims for any natural law, as the majority correctly found, let alone for multiple natural laws.

step one, step two operates to save those claims. It is telling here, however, that American Axle could never point to an inventive concept over and above the “desired results” that the claimed process sought to achieve. That is another reason the decision in this case is narrowly tailored, and is unlikely to have a broad impact.

Finally, American Axle argues it is somehow a virtue that its claims could neatly fit within the “abstract idea” exception to Section 101 as well. *See* Pet. at 9. In its appellate brief, Neapco made an alternative argument that the claims are ineligible as directed to the abstract idea of “tuning”—what the Court ultimately found to be the “ad hoc trial-and-error process of changing the characteristics of a liner.” Op. at 15. That argument followed directly from the district court’s holding that “the Asserted Claims are nothing more than applying a law of nature to a conventional method to achieve *an abstract solution* to a problem[.]” Appx18. The majority did not reach that issue because it affirmed on natural-law grounds. That these claims suffer from multiple fatal flaws is no basis to question the majority’s holding, and no reason for *en banc* review.

II. The Majority Followed Binding Supreme Court Precedent In Rejecting American Axle’s Attempts To Identify An “Inventive Concept”

American Axle next contends that the majority “created a requirement” that “the claims as written must recite precisely how to make and use a particular invention.” Pet. at 15. This “new” standard, according to American Axle,

“subsumes the enablement requirement of Section 112.” *Id.* at 7, 15. The majority did no such thing.

Rather, the majority made two points, both of which follow from well-established, binding precedent. The first is that it is the *claims* that matter when analyzing patent-eligibility under § 101. As the majority explained, “the solution” to the “desired result[.]” of tuning to one or more modes of vibration “is *not claimed* in the patent.” *Id.* at 13-14 (“The elements of the method here that AAM argues take the patent outside the realm of ineligible subject matter...are not actually claimed....”); *id.* at 20 (“Section 101 is concerned with...the claims at issue....”).

Rejecting a misguided attempt to rewrite claims to save them from ineligibility is not some new, “pseudo” version of enablement (Pet. at 16); it is a firmly entrenched principle of this Court’s § 101 jurisprudence. Op. at 13 (citing and quoting relevant authority). Indeed, the majority even recognized that “[t]his case might well be significantly different, if” American Axle’s claims included specific mechanisms for achieving the desired goal. *Id.* at 15.

The second point is that American Axle’s claiming of a desired goal, rather than any means of achieving it, further confirms ineligibility. This too is not new. It comes from the earliest Supreme Court cases on patent eligibility. As the majority explained, “[t]he claiming of a natural law runs headlong into the very problem repeatedly identified by the Supreme Court in its cases shaping our eligibility

analysis.” Op. at 15 (citing and discussing authority). “As the Supreme Court stated in *Le Roy* [], “[a] patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from making the same thing by any means whatsoever.” *Id.*

The *Morse* case illustrates this principle: although Samuel Morse was entitled to seven claims on his telegraph machine, his eighth, which sought to patent the use of “electro-magnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances,” was unpatentable. 56 U.S. at 112. “It is impossible to misunderstand the extent of this claim,” the Court explained, because “it matters not by what process or machinery the result is accomplished.” *Id.* at 112-13; *see also Wyeth*, 30 F. Cas. at 727.

One cannot casually disregard the legal principle articulated in *Le Roy* and *Morse* as relevant only to enablement or written description. *Morse* and *Le Roy*, for example, are cited approvingly by the Supreme Court in every single major decision on Section 101: *Alice*, *Mayo*, *Diamond v. Diehr*, *Bilski*, *Benson*, *Parker v. Flook*, and others. *See, e.g., Bilski v. Kappos*, 561 U.S. 593, 649 (2010) (“Morse’s patent on electromagnetism for writing would pre-empt a wide swath of technological developments.”). Moreover, as the majority opinion discusses at length, the Supreme Court’s more recent Section 101 cases involving laws of nature—including

Diamond v. Diehr and *Parker v. Flook*—likewise draw the very same “distinction between results and means.” Op. at 16-20.

This Court too has repeatedly echoed the importance of the distinction between results and means in its own Section 101 cases. Op. at 15-16 & n.5. *Electric Power*, for example, explained that there is “an important common-sense distinction between ends sought and particular means of achieving them, between desired results (functions) and particular ways of achieving (performing) them.” 830 F.3d at 1356. Claims that do not recite “some ‘particular implementation,’” but instead “purport to monopolize every potential solution to the problem” sought to be solved, run afoul of Section 101. *Id.* The Court observed: “the essentially result-focused, functional character of claim language has been a frequent feature of claims held ineligible under § 101.” *Id.* But that observation is not a “freestanding basis for [an] ineligibility holding;” instead it is “one helpful way of double-checking the application of the Supreme Court’s framework to particular claims.” *Id.*

Interval Licensing, 896 F.3d at 1342-43, spelled out the same proposition. Op. at 16-17. “In *Interval Licensing*, we reiterated the importance of this distinction in describing prior Supreme Court cases in which inventors ‘lost...claim[s] that encompassed all solutions for achieving a desired result’ because ‘the claims failed to recite a practical way of applying an underlying idea...[and] instead were drafted

in such a result-oriented way that they amounted to encompassing ‘the principle in the abstract’ no matter how implemented.’” *Id.* (quoting 896 F.3d at 1343).

Using this “double-check” against the Supreme Court’s framework is precisely what the majority and the district court did in this case. Op. at 15-20; Appx16-17. The majority applied the *Alice/Mayo* two-part framework to reach its conclusion that the claims merely recite the bare instruction to “apply” Hooke’s law in a particular technological environment. And in rejecting American Axle’s attempts to identify an inventive concept, the majority simply observed that the claims go no further than reciting the idea of applying a natural law, without more, to achieve a desired result. The means, or patentable application, are not claimed.

American Axle’s petition fails to cite, discuss, or distinguish even a single one of the Supreme Court and Federal Circuit cases that prohibit the patenting of a result alone under § 101. And even if this Court disagreed with the policy or logic of those Supreme Court cases, it cannot overrule them.

In any event, that American Axle’s claims may *also run afoul* of other sections of the Patent Code, including the enablement requirement of Section 112, is uncontroversial. The “concern that drives” the exceptions to Section 101 is “pre-emption.” *Alice*, 573 U.S. at 216. One would expect that claims so broad as to preempt the use of a natural law, even in a narrow technological context, would fail to meet the requirement that the specification “enable the full scope of a claimed

invention.” *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1241 (Fed. Cir. 2003). As even the *Morse* case makes explicit, the breadth of a claim is relevant to the patent-eligibility inquiry.

But although Section 112 may *also* operate to invalidate these claims, that does not mean that courts may ignore Section 101. As the Supreme Court has already decided, Section 101 is a “threshold” issue. *Bilski*, 561 U.S. at 602.

Indeed, in *Mayo* the government asserted that the other sections of the patent code—Sections 102, 103, and 112—should do the work of invalidating broad claims that may also be invalid under 101. *Mayo*, Brief for the United States As Amicus Curiae Supporting Neither Party, No. 10-1150, at 32 (“The remaining provisions of Title 35...are the principal tools that Congress has provided for drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not.”). The Supreme Court rejected that position. 566 U.S. at 88-91. In doing so, the Court acknowledged that a Section 101 inquiry “might sometimes overlap” with other sections including 112. *Id.* “But that need not always be so. And to shift the patent-eligibility inquiry entirely to these later [statutory] sections risks creating significantly greater legal uncertainty, while assuming that those sections can do work that they are not equipped to do.” *Id.* at 90.

Thus, it is well settled, and beyond the purview of this Court, whether it would be good policy to force trial courts to proceed on questions like enablement before reaching § 101.² Of course, there are strong policy reasons for preferring the framework—treating Section 101 as a threshold inquiry—that the Supreme Court has mandated. *See, e.g., Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 717-20 (Fed. Cir. 2014) (Mayer, J., concurring).

Finally, American Axle is wrong to suggest that Section 101 would somehow “swallow” the enablement requirement of Section 112. As the majority explained, the two statutory requirements serve “different function[s].” Op. at 20. Even if most claims that fail the Section 101 threshold inquiry would also fail the enablement requirement (as American Axle’s claims here surely would), there are many claims that recite patentable subject matter, but are not enabled. That alone confirms the different scopes of these two provisions, and undermines American Axle’s assertion.

III. The Majority Did Not Resolve Fact Disputes

American Axle argues that the majority conducted its own fact-finding at step two of *Alice* by concluding that it was “well understood, routine and conventional”

² American Axle repeatedly claims that Neapco “stud[ied]” the ‘911 patent. Pet. at 17. That is contrary to the evidence in the case. *See* Appellee Br. at 57-59 (citing record evidence). Nevertheless, this assertion has no bearing on whether the majority applied an incorrect *legal* standard under Section 101.

to use tuned liners to attenuate bending mode vibration. Pet. at 11-13. That too misreads the majority's opinion.

Nowhere does the majority state that using liners to attenuate bending mode vibration was "well understood, routine and conventional." Rather, the majority merely observed that American Axle's argument that tuning to attenuate bending mode is somehow new is directly contrary to the disclosure of its own patent. As the majority points out, the '911 patent expressly refers to prior art devices that are tuned to specifically attenuate bending mode vibration. Op. at 12-13, n.3.

The dissent and American Axle take issue with whether it was known to tune *liners* specifically to attenuate bending mode, as opposed to *dampers* generally, but ultimately "it makes no difference to the section 101 analysis whether the use of liners to attenuate bending mode vibrations was known in the prior art." Op. at 13 n.3. That is because attenuating bending mode vibration is not a step in the allegedly inventive process; rather, it is merely the desired result to be achieved if the claimed process is followed. Critically, American Axle never disputes that its claims recite the "desired goal," and in its Petition, American Axle admits it. Pet. at 16 (referring to the "*desired goal* of attenuating multiple vibration modes"). "[T]his direction to engage in a conventional, unbounded trial-and-error process does not make a patent eligible invention, *even if the desired result to which that process is directed would be new and unconventional.*" Op. at 21-22.

CONCLUSION

American Axle's Petition should be denied.

Dated: December 17, 2019

Respectfully submitted,

/s/ J. Michael Huget

J. Michael Huget

Sarah E. Waidelich

HONIGMAN LLP

315 E. Eisenhower Parkway, Suite 100

Ann Arbor, MI 48108

(734) 418-4254

Dennis J. Abdelnour

HONIGMAN LLP

155 North Wacker Drive, Suite 3100

Chicago, IL 60606

(312) 701-9300

*Counsel for Defendants-Appellees Neapco
Holdings LLC and Neapco Drivelines LLC*

CERTIFICATE OF FILING AND SERVICE

I certify that, on December 17, 2019, I electronically filed the foregoing NEAPCO'S RESPONSE TO COMBINED PETITION FOR REHEARING AND REHEARING EN BANC with the Clerk of Court using the CM/ECF System, which will send notice of such filing to all registered users.

I further certify that, upon acceptance by the Court, the required paper copies of the foregoing will be deposited with United Parcel Service for delivery to the Clerk, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, 717 Madison Place, N.W., Washington, D.C. 20439.

Dated: December 17, 2019

Respectfully submitted,

/s/ J. Michael Huget
J. Michael Huget

Counsel for Defendants-Appellees Neapco Holdings LLC and Neapco Drivelines LLC

CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Circuit Rule

32(a) because:

this brief contains 3,885 words, excluding the parts of the brief
exempted by Fed. R. App. P. 32(f).

2. The brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5)

and the type style requirements of Fed. R. App. P. 32(a)(6) because:

this brief has been prepared in a proportionally spaced typeface using
Microsoft Word in 14 point Times New Roman.

Dated: December 17, 2019

Respectfully submitted,

/s/ J. Michael Huget

J. Michael Huget

*Counsel for Defendants-Appellees Neapco
Holdings LLC and Neapco Drivelines LLC*